

## INTERFERENCE DIGEST

Interference No. 105,489

Paper No.

Name: Robert G. Pergolizzi et al.

Serial No.: 08/479,995

Patent No.

Title: Assay method utilizing polynucleotide sequences

Filed: 06/07/95

Interference with Urdea et al.

### DECISION ON MOTIONS

Administrative Patent Judge, \_\_\_\_\_ Dated, \_\_\_\_\_

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### FINAL DECISION

Board of Patent Appeals and Interferences, \_\_\_\_\_ Dated, \_\_\_\_\_

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Court, \_\_\_\_\_ Dated, \_\_\_\_\_

### REMARKS

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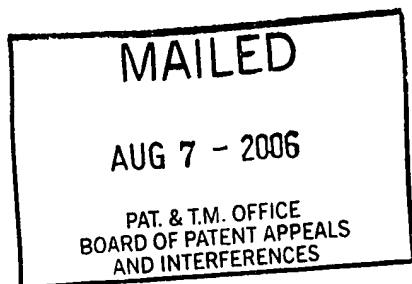
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This should be placed in each application or patent involved in interference in addition to the interference letters.



## UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES  
BOX INTERFERENCE, WASHINGTON, D.C. 20231



Filed by: Judge Richard Torczon  
Telephone: 571-272-4683  
Facsimile: 571-273-0042

Applicants: PERGOLIZZI  
Application No.: 08/479,995  
Filed: 06/07/95  
For: Assay method utilizing polynucleotide  
sequences

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,489.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

/Richard Torczon/  
RICHARD TORCZON  
Administrative Patent Judge

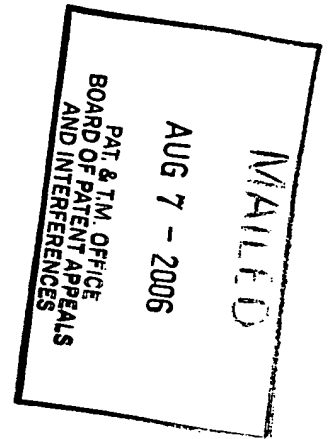
UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,489 (RT)  
(From Technology Center 1600)

CHIRON DIAGNOSTICS CORPORATION  
(5,124,246),<sup>1</sup>  
Junior Party,

v.

ENZO BIOCHEM, INC.  
(08/479,995),<sup>2</sup>  
Senior Party.



DECLARATION - Bd.R. 203(b)<sup>3</sup>

By TORCZON, Administrative Patent Judge.

1       A.   Declaration of interference

2       An interference is declared pursuant to 35 U.S.C. 135(a). Details of the application,  
3 patent, count, and claims designated as corresponding to the count appear under headings E  
4 and F of this DECLARATION.

5       B.   Designation to manage

6       Administrative Patent Judge Richard Torczon has been designated to manage the  
7 interference. Bd. R. 104(a).

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<sup>1</sup> Attorney docket # 2300004623.

<sup>2</sup> Attorney docket # ENZ-11(C2)(D1)(C2).

<sup>3</sup> "Bd.R. x" may be used as shorthand for "37 C.F.R. § 41.x". 69 Fed. Reg. 49960, 49961 (12 Aug. 2004).

1 C. Standing order

2 A copy of the Trial Section STANDING ORDER [SO] (Paper 2) accompanies this  
3 DECLARATION. The STANDING ORDER applies to this contested case.

4 D. Conference call to set dates

5 A telephone conference call to set dates for action in this contested case is scheduled for  
6 3 p.m. (Eastern) on 27 September 2006. (The Board will initiate the call.)

7 No later than 25 September 2006, each party shall file and serve (SO ¶¶ 10.1 & 105) a  
8 list of the motions (Bd. R. 120; Bd. R. 204; SO ¶¶ 104.2.1, 120 & 204) the party intends to file.

9 A sample schedule for taking action during the motion phase appears as Form 2 in the  
10 STANDING ORDER. Counsel are encouraged to discuss the schedule prior to the conference  
11 call and to agree on dates for taking action. A typical motion period lasts approximately eight (8)  
12 months. Counsel should be prepared to justify any request for a shorter or longer period.

13 E. The parties to this interference

14 Junior Party

15 Patent: 5,124,246 (07/340,031, filed 18 April 1989)

16 Title: Nucleic acid multimers and amplified nucleic acid  
17 hybridization assays using same

18 Inventors: Michael S. Urdea of Alamo, Brian Warner of Martinez, and  
19 Thomas Horn of Berkeley, all of California

Senior Party

Application: 08/479,995, filed 7 June 1995

Title: Assay method utilizing polynucleotide sequences

Inventors: Robert G. Pergolizzi of New Milford, New Jersey; Jannis G. Stavrianopoulos of New York City, New York; Elazar Rabbani of New York City, New York; Dean L. Engelhardt of New York City, New York; Stan Kline of Brooklyn, New York; and Paula J. Olsiewski of New York City, New York.

F. Count, claims, and accorded benefit

Count 1

The nucleic acid hybridization assay of 5,124,246 claim 53.

The claims of the parties are:

Chiron: 1-59

Enzo: 283-362, 364, 365, 382, 383, 400, 401, 403, 404, 406, 407, 409-439,

441-505, 507, 508, 510, 511, and 528-547<sup>4</sup>

The claims corresponding to Count 1:

Chiron: 39-41 and 43-56

Enzo: 283-362, 364, 365, 382, 383, 400, 401, 403, 404, 406, 407, 409-439,

441-505, 507, 508, 510, 511, and 528-547

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<sup>4</sup> There is at least one multiply dependent claim that provides basis for another multiply dependent claim in violation of 35 U.S.C. 112(5).

The claims not corresponding to Count 1:

Chiron: 1-38, 42, and 57-59

Enzo: None

The benefit accorded for Count 1:

Chiron: 07/252,638, filed 30 September 1988;

07/185,201, filed 22 April 1988; and

07/109,282, filed 15 October 1987.

Enzo: 08/342,667 filed 21 November 1994;

07/805,274, filed 10 December 1991;

07/607,787, filed 26 October 1990;

06/922,757, filed 24 October 1986; and

06/491,929, filed 5 May 1983.

G. Heading to be used on papers; exhibit numbers

Addendum 1 provides the heading that shall be used on all papers filed in the contested case. See SO ¶ 106.1.1.

The range of exhibit numbers is assigned as follows (Bd.R. 154(c)(1); SO ¶ 154.2.1):

Enzo: 1001-1999.

Chiron: 2001-2999.

H. Order form for requesting file copies

When requesting copies of files, use of Addendum 2 (SO Form 4) will greatly expedite processing of the request. Please attach a copy of Parts E and F of this DECLARATION with a

1 hand-drawn circle around the patents and applications for which a copy of a file wrapper is  
2 requested.

Attachment: Copy of the application claims for 08/479,995

Enclosure: Copy of STANDING ORDER (Paper 2)

cc (via overnight delivery service):

Thomas Ciotti, MORRISON & FOERSTER, of Palo Alto, California, for Chiron Diagnostics Corp.

Ronald C. Fedus, ENZO BIOCHEM, INC., of New York City, New York, for Enzo Biochem, Inc.

**ADDENDUM 1**

Filed on behalf of: [Name of Party]  
By: [Name of lead counsel  
Name of backup counsel  
Street address  
City, State, and ZIP Code  
Tel:  
Fax: ]

Paper No. [Leave blank]

UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

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Patent Interference No. 105,489 (RT)

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CHIRON DIAGNOSTICS CORPORATION  
(5,124,246),  
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TITLE OF PAPER



**ADDENDUM 2****FILE COPY REQUEST**  
Patent Interference No. 105,489

Attach a copy of sections E and F of this DECLARATION to this REQUEST. On the copy, circle each patent and application that you are requesting. Include the following information to facilitate processing of this REQUEST:

1. Charge fees to USPTO Deposit Account No. \_\_\_\_\_
2. Complete address,<sup>5</sup> including street, city, state, ZIP code, and telephone number:  
\_\_\_\_\_  
\_\_\_\_\_  
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3. Telephone, including area code: \_\_\_\_\_

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<sup>5</sup> Provide a street address, NOT a Post Office Box. The Office of Public Records uses a commercial overnight delivery service rather than the United States Postal Service to deliver file copies.